

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Super Stud Building Products, Inc.

Serial No. 74/636,162

Hugh D. Jaeger for Super Stud Building Products, Inc.

Chad M. Smith, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney)

Before Simms, Seeherman and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Applicant has appealed from the refusal of the
Examining Attorney to register SUPER STUD, in the stylized
form shown below, for:

Metal structural framing, namely studs,
track, deflection clip, deflection
strut, deflection track, utility angle,
joist hangers, joist support clip,
angle clip, end stiffener clip, web
reinforcement plate, tension strap,
structural hat channel, screw
fasteners, radius track, boxed and I-

shaped structure, brake formed structure, prefabricated frame, sheet steel, metal drywall products, namely drywall stud, drywall track, drywall hat channel, zee furring, grommet, resilient channel, cold rolled channel, knee wall bracket, galvanized rod, furring channel clip, bead and corner bead, metal trim, utility angle, hanger wire, and tie wire.¹

Registration has been refused on three bases:

1) The mark so resembles the mark SUPER STUD (STUD disclaimed), registered on the Supplemental Register for "structural beam for concrete form assemblies,"² that applicant's use of its mark on its identified goods is likely to cause confusion or mistake or to deceive. Section 2(d) of the Act, 15 U.S.C. 1052(d);³

2) The merely descriptive words SUPER STUD are required to be disclaimed. Section 6(a) and 2(e)(1) of the Act, 15 U.S.C. 1056(a), 1052(e)(1);

¹ Application Serial No. 74/636,162, filed February 21, 1995, asserting first use and first use in commerce on June 1, 1973.

² Registration No. 1,705,993, issued March 2, 1992; Section 8 affidavit accepted.

³ Registration was also finally refused pursuant to Section 2(d) on the basis of Registration No. 1,579,028. Although both applicant and the Examining Attorney argued the merits of this refusal in their briefs, Office records show that this registration was cancelled in 1996, prior to the issuance of the final Office action, for failure to file a Section 8 affidavit of use.

3) Applicant is required to submit acceptable substitute specimens because the specimens filed with the application are unacceptable to show use of the mark on the goods. Trademark Rule 2.56, 37 C.F.R. 2.56.

Applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

In its brief applicant has limited its arguments to the refusal under Section 2(d). Accordingly, it is presumed that applicant has conceded the correctness of the Examining Attorney's requirements for a disclaimer and for substitute specimens. In any event, these requirements are well taken, and are hereby affirmed.

Specifically, Section 6(a) of the Act provides that the Commissioner may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) prohibits the registration of marks which are merely descriptive of the goods. The term SUPER STUD in applicant's mark is merely descriptive, STUD being a generic word for some of the goods, as shown by applicant's identification, which specifically includes "studs." The word SUPER, as used in the mark, is a laudatory description of STUD, such that the term SUPER STUD as a whole is

laudatorily descriptive of some of applicant's goods. We note that applicant attempted to overcome the requirement for a disclaimer by asserting that its mark had acquired distinctiveness, but did not submit any evidence in support of that claim, not even a declaration attesting to substantially exclusive and continuous use in commerce for the five years preceding the date the claim of acquired distinctiveness was made. Thus, applicant has not shown that SUPER STUD is not merely descriptive because it has acquired distinctiveness as an indicator of source in applicant.

As for the specimens, we agree with the Examining Attorney that the labels submitted by applicant do not show use of the mark in the special form depicted in the drawing of the application, and therefore do not support registration of that stylized mark. The catalog cover page, although it shows the stylized mark, appears to be only advertising material. Applicant has not shown how it meets the definition of use in commerce, which is defined in Section 45 of the Act as use of a mark "(1) on goods

when (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto.⁴

This brings us to the refusal based on Section 2(d) with respect to the mark SUPER STUD for structural beam for concrete form assemblies. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See **Federated Food, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The goods identified in the cited registration are structural beams for concrete form assemblies. This identification is broad enough to include the metal structural framing identified in applicant's application. Thus, we must deem the goods to be, in part, legally identical.

⁴ The Statute makes an exception to these requirements "if the nature of the goods makes such placement impracticable," but since applicant does use labels affixed to the goods, and in fact has submitted labels with SUPER STUD shown in a different typestyle, it is clearly practicable to affix the mark to the goods, and the exception does not apply to applicant's situation.

As for the marks, applicant's mark is identical to the cited mark in pronunciation and connotation, and is virtually identical in appearance. The curved line which forms the "S" in SUPER and STUD is not sufficient to distinguish the marks. Consumers familiar with the registrant's mark for structural beams will, upon seeing applicant's mark on metal structural framing, regard this mark as a variant of the registrant's mark, rather than as an indicator of a separate source for the goods. The marks convey the same commercial impression.

We have kept in mind that the cited mark is registered on the Supplemental Register, a recognition that SUPER STUD is descriptive of the registrant's goods. As a result, the scope of protection to which the registrant's mark is entitled is limited. However, because of the virtual identity of the marks and the goods, we find that applicant's stylized SUPER STUD mark as used on its identified goods is likely to cause confusion with the registrant's mark SUPER STUD for structural beam for concrete form assemblies.

For similar reasons, the fact that applicant's and registrant's goods would be used by sophisticated purchasers, and not the public, does not avoid the likelihood of confusion. That is, the marks and the goods

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are so similar that even knowledgeable purchasers are likely to believe the goods come from the same source.

Decision: The refusals based on likelihood of confusion and the requirements for a disclaimer and for acceptable specimens are affirmed.

R. L. Simms

E. J. Seeherman

T. E. Holtzman
Administrative Trademark Judges
Trademark Trial and Appeal Board